

## **REMARKS**

Claims 8-53 are pending. Claim 21 was amended. Consideration of the following remarks is respectfully requested.

### **§102(b) Claim Rejections**

Claims 8, 14-20, 33, 39-44, and 50-53 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,636,267 to Utsumi (hereinafter “Utsumi”). The Applicant respectfully disagrees and reserves the right to challenge use of Utsumi as a reference at a later time.

**Utsumi** describes a cleaning system for a telephone number list. In Utsumi, a “floppy disk containing the telephone number list is set in the floppy disk drive 4 and a cleaning command is given by designating a list name through a keyboard 7.” *Utsumi, Col. 5, Lines 6-7*. Thus, a single cleaning command (the designated list name) is given to “clean” an entire list of telephone numbers in Utsumi.

**Claim 8** recites a method comprising:

- sequentially initiating dialing of a plurality of telephone numbers included in a list stored by a communications device such that the dialing of each said telephone number is initiated by a respective one of a plurality of sequential commands; and

- deleting, by the communications device, one or more of the telephone numbers from the list when a call to the one or more of the telephone numbers has been completed as a result of the dialing.

It is respectfully submitted that Utsumi does not disclose these features.

As described above, Utsumi describes a system in which a single command is given to clean an entire list of telephone numbers and thus a plurality of telephone numbers are cleaned in response to a single cleaning command. However, Claim 8 recites “sequentially initiating dialing of a plurality of telephone numbers included in a list stored by a communications device **such that the dialing of each said telephone number is initiated by a respective one of a plurality of sequential commands**” and thus differs from the automated system of Utsumi in which the entire list is “cleaned” in response to the single command. Indeed, use of more than a single command runs against the expressed purpose of Utsumi for the automatic rewriting and updating of the telephone number list. *See Col. 8, Lines 16-42*. Withdrawal of the rejection is respectfully requested.

**Claims 9-20** depend either directly or indirectly from claim 8 and are allowable as depending from an allowable base claim. Each of the dependent claims is allowable based on the same rationale discussed with respect to claim 8. These claims are also allowable for their own recited features which, in combination with those recited in claim 8, are neither shown nor suggested in the references of record, either singly or in combination with one another. Withdrawal of the rejection is respectfully requested.

**Claim 33** recites one or more tangible computer-readable media comprising instructions that are executable by a communications device to:

- initiate dialing of a plurality of telephone numbers included in a list stored by the communications device sequentially such that the dialing of each of the plurality of telephone numbers is initiated by a respective one of a plurality of sequential commands; and
- return to one or more of the plurality of telephone numbers that are unanswered.

**Claim 44** recites a communications device comprising a processor and memory having instructions that are executable on the processor to form a list having a plurality of telephone numbers of unanswered telephone calls of the communications device and provide a feature to sequentially initiate dialing of the plurality of telephone numbers included in the list such that the dialing of each of the plurality of telephone numbers is initiated by a respective one of a plurality of sequential commands.

As described above, Utsumi describes a system in which a single command is given to clean an entire list of telephone numbers and thus a plurality of telephone numbers are cleaned in response to a single command. However, Claims 33 and 44 recite **“the dialing of each of the plurality of telephone numbers is initiated by a respective one of a plurality of sequential commands.”** (emphasis added) Thus, the automated system of Utsumi in which the entire list is “cleaned” in response to a single command differs from the

features recited in these claims. Indeed, use of more than one command runs against the expressed purpose of automation of Utsumi. Withdrawal of the rejection is respectfully requested.

**Claims 34-43** depend either directly or indirectly from claim 33 and are allowable as depending from an allowable base claim. Each of the dependent claims is allowable based on the same rationale discussed with respect to claim 33. These claims are also allowable for their own recited features which, in combination with those recited in claim 33, are neither shown nor suggested in the references of record, either singly or in combination with one another. Withdrawal of the rejection is respectfully requested.

**Claims 45-53** depend either directly or indirectly from claim 44 and are allowable as depending from an allowable base claim. Each of the dependent claims is allowable based on the same rationale discussed with respect to claim 44. These claims are also allowable for their own recited features which, in combination with those recited in claim 44, are neither shown nor suggested in the references of record, either singly or in combination with one another. Withdrawal of the rejection is respectfully requested.

**§103(a) Claim Rejections**

Claims 9-33, 34-36, and 45-47 are rejected under 35 U.S.C. §103(a) as being unpatentable by Utsumi. First, it is respectfully submitted that the Examiner

meant to reject claims 9-11 instead of 9-33 as the rejection does not address claims 12-33.

Regardless, in each instance the Examiner has taken Official Notice that “it is well known in the art to use call commands in either abbreviated manual commands, manual or spoken entry methods.” *See Office Action, Pages 7-9*. The Applicant respectfully disagrees. As the Examiner is aware, “it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification.” *In re Lulu*, 747 F.2d 703, 223 USPQ 1257, 1258 (Fed. Cir. 1984). In the present case, such a modification runs counter to the express purpose of automation of Utsumi as described above and therefore such a modification as proposed by the Examiner would not have been made. Therefore, the Examiner’s Official Notice is respectfully submitted as improper and accordingly the Applicant requests citation to a reference or withdrawal of the rejection.

#### **§103(a) Claim Rejections**

Claims 12, 13, 21-32, 37, 38, 48, and 49 are rejected under 35 U.S.C. §103(a) as being unpatentable by Utsumi in view of U.S. Patent No. 5,636,267 to Iwase (hereinafter “Iwase”). The Applicant respectfully disagrees and reserves the right to challenge use of Iwase of a reference at a later date.

**Claim 12** recites “outputting a pre-recorded message associated with at least one of the plurality of telephone numbers **before dialing the at least one of**

**the plurality of telephone numbers.”** (emphasis added). The Examiner, in rejecting this claim, correctly asserts that Utsumi does not specifically teach these features. However, the Examiner then incorrectly applies Iwase to correct the defects of Utsumi.

For example, the Examiner asserts that the “Iwase reference however specifically teach a device to communicate by telephone call and sending the destination phone number a prerecorded message. (Col. 1 line 48-55)” The Examiner also asserts that it “would have been obvious ... to implement a pre-recorded message to be sent to a destination number as taught by Iwase to the Utsumi reference in order **to communicate to destination number users** to be informed for the reason of the phone call.” *See Office Action, Page 9.* Thus, following Iwase and the Examiner’s assertion the telephone number is dialed **and then the prerecorded message is output.** However, as shown above claim 12 recites “**outputting a pre-recorded message ... before dialing** the at least one of the plurality of telephone numbers.”

**Claim 13** is allowable based on its dependence from claim 12 as well as for its own recited features. Withdrawal of the rejection is respectfully requested.

**Claim 21** has been amended, and as amended (portions of the amendment appear in bold/italics below) recites an apparatus comprising:

- means for receiving a command to dial a first of a plurality of telephone numbers included in a list;

- means for outputting a pre-recorded message that is associated with the first of the plurality of telephone numbers;
- means for dialing the first of the plurality of telephone numbers *after the outputting of the pre-recorded message by the outputting means*; and
- means for resolving a call to the first of the plurality of telephone numbers that is a result of the dialing.

Neither Utsumi nor Iwase teach or suggest “means for **dialing the first of the plurality of telephone numbers after the outputting of the pre-recorded message** by the outputting means,” alone or in combination. Withdrawal of the rejection is respectfully requested.

In rejecting **claims 22-24**, the Examiner has again taken Official Notice that “it is well known in the art to use call commands in either abbreviated manual commands, manual or spoken entry methods.” *See Office Action, Pages 10-11*. The Applicant respectfully disagrees. As the Examiner is aware, “it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification.” *In re Lulu*, 747 F.2d 703, 223 USPQ 1257, 1258 (Fed. Cir. 1984). In the present case, such a modification runs counter to the express purpose of Utsumi as described above (e.g., at Col. 8, Lines 16-42) and therefore such a modification as proposed by the Examiner is not proper and cannot be undertaken

via Official Notice. Iwase does not correct this defect, alone or in combination with the assertions. Withdrawal of the rejection is respectfully requested.

**Claims 25-32** depend either directly or indirectly from claim 21 and are allowable as depending from an allowable base claim. Each of the dependent claims is allowable based on the same rationale discussed with respect to claim 21. These claims are also allowable for their own recited features which, in combination with those recited in claim 21, are neither shown nor suggested in the references of record, either singly or in combination with one another. Withdrawal of the rejection is respectfully requested.

Regarding **claims 37 and 48**, as discussed above the Examiner has asserted the combination of Utsumi and Iwase as it “would have been obvious ... to implement a pre-recorded message to be sent to a destination number as taught by Iwase to the Utsumi reference in order to communication to destination number users to be informed for the reason of the phone call.” *See Office Action, Page 13*. Withdrawal of the rejection is respectfully requested as this is clearly not the claimed feature. **Claim 38** is allowable based on its dependence from claim 37 as well as for its own recited features. **Claim 49** is allowable based on its dependence from claim 48 as well as for its own recited features. Withdrawal of the rejections is respectfully requested.



**Conclusion**

The Application is in a condition for allowance. The Applicant respectfully requests reconsideration and issuance of the present application. Should any issue remain that prevents immediate issuance of the application, the Examiner is requested to contact the undersigned attorney to discuss the unresolved issue.

Respectfully submitted,

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